

REMARKS

Claims 1-8, 23-29, and 35-41 are pending, with claims 1, 3, and 23 being independent.

Claim 3 has been amended to correct an informality. No new matter has been added.

Reconsideration and allowance of the above-referenced application are respectfully requested.

Rejection under 35 U.S.C. § 112:

Claim 3 stands rejected under 35 U.S.C. § 112, second paragraph. Claim 3 has been amended to correct the antecedent basis issue. Thus, withdrawal of the rejection of claim 3 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Rejections under 35 U.S.C. § 103:

Claims 1, 3, 4, 6, 7, 23, 25, 28, 36, 37, 39, and 40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pub. No. 2005/0132083 to Raciborski et al. ("Raciborski") in view of U.S. Pub. No. 2003/0028899 to MacInnis et al. ("MacInnis"). Claims 5, 26, and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raciborski in view of MacInnis and in further view of U.S. Pat. No. 5,586,260 to Hu. Claims 8, 27, 38, and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raciborski in view of U.S. Pat. No. 6,006,034 to Heath et al. ("Heath") and in further view of Hu. Claim 29 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raciborski in view of MacInnis and in further view of U.S. Pat. No. 7,233,981 to Tenereillo et al. ("Tenereillo"). Claims 2, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being

unpatentable over Raciborski in view of MacInnis and in further view of U.S. Pub. No. 2003/0135650 to Kano et al. ("Kano"). These contentions are respectfully traversed.

Initially, it is respectfully submitted that the Office's use of Raciborski as prior art is not proper. Raciborski's non-provisional patent application, as cited by the Office, was filed and published after the filing date of the instant application and claims priority to three provisional applications, which were filed before the filing date of the instant application. The Office has not provided evidence that the relied upon subject matter of Raciborski is also present in Raciborski's priority documents, and thus, the Office has not met its burden of establishing that Raciborski can serve as a reference under 35 U.S.C. 103(a).<sup>1</sup> For at least this reason, all of the rejections based on Raciborski are improper and should be withdrawn.

In addition, independent claim 1 recites, "...sending information specifying an acceptable authentication procedure; receiving an authentication procedure update request from the client in response to client processing of the information specifying an acceptable authentication procedure ..."<sup>2</sup> The Office asserts that MacInnis teaches this subject matter in paragraph [0012].<sup>3</sup> The Office admits that MacInnis does not teach a request for descriptors being received from the client, but goes on to suggest that this would be obvious in view paragraph [0007] in MacInnis, which describes downloading schemes involving client-server paradigms.<sup>4</sup> However, paragraph [0007] in MacInnis is in the background section and is describing prior art that

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<sup>1</sup> See MPEP 706.02(f)(1)(I)(B) and MPEP 2136.03(III).

<sup>2</sup> Emphasis added.

<sup>3</sup> See 11-27-2009 Office Action at pages 4-5.

<sup>4</sup> See 11-27-2009 Office Action at page 5.

MacInnis explicitly discourages using. Rather, the explicit objective in MacInnis is to not have the client need to send a request:

The present invention solves the aforementioned problems by providing a system and method for selectively downloading software and data modules to terminals in a network without requiring communication between the terminal and the downloading source.<sup>5</sup>

Thus, MacInnis actually teaches away from the combination proposed by the Office, and the proposed combination cannot be made to render the claimed subject matter unpatentable.

Furthermore, in order to reject the claimed subject matter, the Office treats the download manager of Raciborski as equivalent to an authentication procedure.<sup>6</sup> The Office further notes that there will be different versions of the download manager for different client computer systems, and the Office concludes that it would have been obvious to provide an appropriate client-compatible version of the download manager to the client.<sup>7</sup> However, this fails to consider the claimed subject matter as a whole. Claim 1 is clearly directed to providing an appropriate program to a client to authenticate a user based on a document being accessed by the user and the action requested with respect to that document. Raciborski describes a system for downloading a plurality of content objects from the Internet to a computer of a user.<sup>8</sup> MacInnis describes a system for downloading different versions of software or data modules into a plurality of terminals having different compatibility interfaces.<sup>9</sup> Neither of these references are directed to controlling access to a document by sending information specifying an acceptable authentication

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<sup>5</sup> See MacInnis at ¶ [0011].

<sup>6</sup> See 11-27-2009 Office Action at page 15.

<sup>7</sup> See 11-27-2009 Office Action at pages 4-5.

<sup>8</sup> See Raciborski at Abstract.

<sup>9</sup> See MacInnis at Abstract.

procedure after determining whether user authentication is needed based on the document identifier and the action.

The Office is respectfully reminded that the section 103 inquiry is not whether any differences between the references and the claims themselves would have been obvious; rather, it is whether the claimed combination as a whole would have been obvious.<sup>10</sup> An attempt to parse the various features of the claims into discrete sub-components or to detach features from other related features ignores the context and meaning of the claims taken in their entirety and is thus improper and inconsistent with MPEP § 2141.02(I). In the present Office Action, evidence of such improper parsing of the claim language is provided when the Office states:

The 'information' specifying an acceptable authentication procedure is not defined. It is unclear what this information pertains to.

It is also noted that the claim language does not tie together the authentication procedure to the user. User authentication is first determined and subsequently information specifying an acceptable authentication procedure is sent. Subsequently, a program is sent that performs user authentication.

First, with respect to the information, there is no lack of clarity. The information, as recited in the claim, specifies an acceptable authentication procedure, which is clearly one or more procedures that the server has determined to be acceptable in view of the prior determination that user authentication is needed based on the document identifier and the action. For example, as described in the present application, "The server 320 can respond as to whether authentication is needed, and if so, the type of authentication to be used, including potentially multiple types of

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<sup>10</sup> See MPEP § 2141.02(I).

acceptable authentication mechanisms, from which the client 310 can choose which one to use. If the client 310 does not already have the specified authentication functionality, the client 310 can then request a corresponding authentication update.”<sup>11</sup>

Second, the claim language does in fact tie together the authentication procedure and the user. Claim 1 recites, “receiving, at a server, a request from a client to take an action with respect to an electronic document; retrieving a document identifier from the request; determining whether user authentication is needed based on the document identifier and the action; subsequent to retrieving the document identifier, sending information specifying an acceptable authentication procedure; receiving an authentication procedure update request from the client in response to client processing of the information specifying an acceptable authentication procedure; obtaining, at the server and in response to the authentication procedure update request, a software program comprising instructions operable to cause one or more data processing apparatus to perform operations effecting the authentication procedure; and sending the software program to the client for use in identifying a current user and controlling the action with respect to the electronic document based on the current user and document-permissions information associated with the electronic document.”<sup>12</sup> Thus, all the claim elements are clearly tied together into a whole that Raciborski and MacInnis fail to teach or suggest.

For all of the above reasons, independent claim 1 should be in condition for allowance. Neither Hu, Heath, Tenereillo nor Kano cure the noted deficiencies of Raciborski and MacInnis.

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<sup>11</sup> See Specification at ¶ 55.

<sup>12</sup> Emphasis added.

Thus, dependent claims 2 and 4-8 should be allowable based on the above arguments and the additional recitations they contain.

Independent claim 3 recites, “receiving, at a server, a request from a client to take an action with respect to an electronic document; obtaining, at the server and in response to the request, a software program comprising instructions operable to cause one or more data processing apparatus to perform operations effecting an authentication procedure; sending the software program to the client for use in identifying a current user and controlling the action with respect to the electronic document based on the current user and document-permissions information associated with the electronic document; receiving an updated authentication procedure; receiving a subsequent request from the client to take the action with respect to the electronic document; obtaining, at the server and in response to the subsequent request, a new software program comprising instructions operable to cause one or more data processing apparatus to perform operations effecting the updated authentication procedure; and sending the new software program to the client for use in identifying the current user and controlling the action with respect to the electronic document based on the current user and the document-permissions information associated with the electronic document.”<sup>13</sup> Thus, independent claim 3 should be in condition for allowance for at least reasons similar to those addressed above with respect to claim 1.

Independent claim 23 recites, “a client that sends an authentication procedure update request to a server in response to client processing of information received from the server, wherein the information received from the server specifies one or more acceptable authentication

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<sup>13</sup> Emphasis added.

procedures; the server that receives the authentication procedure update request, and in response to the client, the server obtains and sends a software program comprising instructions operable to cause one or more data processing apparatus to perform operations effecting an authentication procedure; and wherein the client uses the software program to identify the current user and control an action with respect to an electronic document based on the current user and document-permissions information associated with the electronic document, and wherein the action comprises an action taken with respect to the electronic document subsequent to opening the electronic document at the client.”<sup>14</sup> Thus, independent claim 23 should be in condition for allowance for at least reasons similar to those addressed above with respect to claim 1. In addition, it is noted that the Office has provided no explanation of what in the art is considered to be “the action” and how this action is “an action taken with respect to the electronic document subsequent to opening the electronic document at the client”, as required by the claim. Moreover, dependent claims 24-29 and 35-41 should be allowable based on the above arguments and the additional recitations they contain.

### CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as

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<sup>14</sup> Emphasis added.

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an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

A formal notice of allowance is respectfully requested. Absent this, a telephone interview with the Examiner and the Examiner's supervisor is respectfully requested.

Please apply any necessary charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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